



Confirmation No.: 9070

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Robert H. Wollenberg	Examiner:	M. C. Tran
Serial No.:	10/779,421	Group:	Art Unit 1639
Filing Date:	February 13, 2004	Docket:	T-6320 (538-66)
For:	HIGH THROUGHPUT SCREENING METHODS FOR LUBRICATING OIL COMPOSITIONS	Dated:	October 27, 2006

MAIL STEP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO OFFICE ACTION SETTING FORTH
REQUIREMENT FOR RESTRICTION AND AN ELECTION OF SPECIES**

Sir:

In the Office Action dated September 22, 2006, the Examiner issued a requirement for restriction under 35 U.S.C. §121 categorizing original Claims 1-34 as follows: Group I made up of Claims 1-21 drawn to a high throughput method for screening lubricating oil composition, classified in class 435, subclass DIG 14 and Group II made up of Claims 22-32, drawn to a system, classified in class 436, subclass 43, with Claims 33 and 34 being categorized as linking the inventions of Group I and Group II.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: MAIL STOP AMENDMENT; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 27, 2006.

Dated: October 27, 2006



Michael E. Carmen

In response to the requirement for restriction set forth by the Examiner, applicant provisionally elects, with traverse, to prosecute the subject matter of Group I, i.e., Claims 1-21, for examination in this application. Applicant respectfully reserves the right to file one or more divisional applications to non-elected Claims 22-32 in the event the Examiner's restriction requirement is made final and such claims are canceled from the present application.

It is respectfully submitted that the requirement for restriction between the claims of Group I and Group II is improper and should be withdrawn.

Restriction is proper only if the claims are either independent or patentably distinct and the search and examination of the entire application would impose a serious burden on the examiner (MPEP § 803). Applicant respectfully traverses the Restriction Requirement because the Examiner has not provided sufficient reasons to show that such a burden exists. Here, all of applicant's claims are directed either to a method for screening lubricating oil compositions under program control (Claims 1-21); or to a system for screening a plurality of lubricating oil compositions (Claims 22-32). Applicant therefore submits that the Examiner, in searching for the subject matter of the claims of Group I, would necessarily find art related to the system for screening lubricating oil compositions under program control of the claims of Group II.

Accordingly, applicant respectfully requests that the Examiner withdraw, or at the very least modify, the requirement for restriction and provide an action on the merits of nonelected Claims 22-32.

With respect to the Examiner's requirement for an election of species herein, applicant elects the following species:

LUBRICATING OIL COMPOSITION LIBRARY

Applicant elects the following species for the lubricating oil composition: (1) a motor oil as the species of the base oil and (2) a detergent as the species of the lubricating oil additive. All of the elected claims, i.e., Claims 1-21, are believed to be readable on the elected species.

ELASTOMER

Applicant elects an elastomer seal as the species of the elastomer. All of the elected claims, i.e., Claims 1-21, are believed to be readable on the elected species.

An early and favorable action on the merits of the claims presented herein are respectfully requested.

Respectfully submitted,



Michael E. Carmen
Reg. No. 43,533
Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
(Phone) (516) 992-1848
(Facsimile) (516) 739-0981
MEC:bg